

REMARKS/ARGUMENTS

I. General Remarks.

Applicants respectfully request that the Examiner reconsider the application in view of the following remarks.

II. Disposition of the Claims.

At the time of the Office Action, Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, 24-29, 31-37, 39, and 40 were pending in the application. Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, 24-29, 31-37, 39, and 40 were rejected.

III. Remarks Regarding Rejections Under 35 U.S.C. § 112

A. Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, 24-29, 31-37, 39, and 40 Satisfy the Written Description Requirement of 35 U.S.C. § 112.

Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, 24-29, 31-37, 39, and 40 were rejected under 35 U.S.C. § 112, first paragraph, as based on a non-enabling disclosure. According to the Examiner, the specification does not support the limitation “about 35% to about 95% by volume water.” Applicants respectfully traverse these rejections for the reasons discussed below.

35 U.S.C. § 112, first paragraph, states: “The specification shall contain a written description of the invention, and of the manner and process or making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most clearly connected, to make and use the same. . .” The Examiner, however, believes that a person of ordinary skill in the art would be able to make and use a cleaning solution comprising from about 10% to about 95% by volume water, based on the disclosure in the specification, but not one comprising the narrower range of about 35% to about 95% by volume water. This, of course, is nonsensical.

In support of his rejection, the Examiner cites *In re Mayhew*, 571 F.2d 1229, 188 U.S.P.Q. 356 (CCPA 1976). However, the Examiner not only misstates the holding of *In re Mayhew*, he also misapplies it to the facts of this case. Contrary to the Examiner’s statement of the case, *In re Mayhew* merely stands for the proposition that claims which fail to recite a necessary element of an invention are not supported by an enabling disclosure. 571 F.2d at 1233, 188 U.S.P.Q. at 358. In his rejection, the Examiner fails to identify a single necessary

element of the invention that is not recited in the claims. As such, the Examiner's reliance on *In re Mayhew* is misplaced. Instead, the Examiner states that Applicant's claimed range "is not based on a critical practice of the claimed invention" and is "intended merely to overcome previous rejections." However, the Examiner fails to cite any portion of the M.P.E.P. or cite any case law that states that claimed ranges must be "based on a critical practice of the claimed invention" or that Applicants motivations for a claim amendment have any bearing to whether or not a claim is enabled. The simple fact is that the Specification discloses a cleaning solution comprising from about 10% to about 95% by volume water, and that the claimed cleaning solution comprising from about 35% to about 95% by volume water clearly falls within this range. As such, the claimed invention is clearly enabled by the Specification.

This is no different from *In re Wertheim*, 541 F.2d 257, 265 (CCPA 1976), where the CCPA held that claims to 35% to 60% solids content were enabled by a disclosure in the specification of 25% to 60% solids content. As explained in *In re Wertheim*, merely arguing lack of literal support in the disclosure is not sufficient to satisfy the Examiner's burden. *Id.* The claimed invention does not have to be described word for word in order to satisfy the written description requirement of § 112. *Id.* "The burden of showing that the claimed invention is not described in the specification rests on the PTO in the first instance, and it is up to the PTO to give reasons why a description not in *ipsis verbis* is insufficient." *Id.* For at least these reasons, the § 112 rejections of Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, 24-29, 31-37, 39, and 40 are improper. As such, Applicants respectfully request that the § 112 rejections of Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, 24-29, 31-37, 39, and 40 be withdrawn.

Applicants also respectfully point out the fact that Claims 25-29, 31-37, 39, and 40 do not even recite the range to which the Examiner objects. In fact, Claims 31 and 39 explicitly recite the range "about 10% to about 95% by volume water," which is the exact range disclosed in paragraph 14 of Applicants' specification. For at least this reason, the § 112 rejections of Claims 25-29, 31-37, 39, and 40 are improper. Therefore, Applicants respectfully request that, at a minimum, the rejections of Claims 25-29, 31-37, 39, and 40 be withdrawn.

IV. Remarks Regarding Rejections Under 35 U.S.C. § 102.

A. Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, 24-29, 31-37, 39, and 40 are not Anticipated by *Doyel II*.

Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, 24-29, 31-37, 39, and 40 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,060,439 issued to Doyel et al. ("*Doyel II*").^{1,2} Applicants respectfully traverse these rejections for the reasons discussed below.

In order to establish a *prima facie* case of anticipation, all the elements of the claimed invention must be found within a single prior art reference. *Dewey & Almy Chemical Co. v. Mimex*, 124 F.2d 986, 52 USPQ 138 (2d Cir. 1942). Applicants respectfully submit that each and every element of Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, 24-29, 31-37, 39, and 40 are not found within the *Doyel II* reference.

Claim 1 recites:

A method of removing an epoxy-based resin coating from a surface comprising applying a cleaning solution comprising a pH-adjusting agent, a solvent, and from about 35% to about 95% by volume water to a surface at least partially coated with an epoxy-based resin, wherein the solvent is selected from the group consisting of dipropylene glycol monomethyl ether, diethylene glycol monomethyl ether, and combinations thereof.

Applicants respectfully submit the *Doyel II* reference fails to teach, suggest, or disclose each of these elements. For example, *Doyel II* fails to teach, suggest, or disclose "applying a cleaning solution . . . to a surface at least partially coated with an epoxy-based resin." Instead, *Doyel II* discloses applying a cleaning solution to a surface at least partially coated with a "polymeric substance that is used in the manufacture of optical products that has a refractive index greater than 1.49." Col. 6, ll. 36-39. These include diethylene glycol bisallyl carbonate ("DEGBAC"), acrylates, methacrylates, methyl methacrylates, polyesters, polystyrene, polycarbonate, phthalate, isocyanate, polyether, urethane, thio or sulfur containing polymers, and halo or chlorine and/or bromine containing polymers. Col. 6, ll. 39-53. *Doyel II*, however, fails to teach, suggest, or disclose using the cleaning solution to remove an epoxy-based resin from a

¹ In the Office Action, the Examiner refers to U.S. Patent No. 6,060,439 as being issued to "Thompson, Arthur J." Thompson is actually the sixth-named inventor. The first-named inventor is Doyel.

² In the Office Action mailed July 1, 2005, the Examiner cited U.S. Patent No. 5,962,383 issued to Doyel et al. ("*Doyel*"). Accordingly, Applicants will refer to U.S. Patent No. 6,060,439 issued to Doyel et al. as *Doyel II*.

surface. For at least this reason, the rejection of Claim 1 is improper. Therefore, Applicants respectfully request that the rejection of Claim 1 be withdrawn.

Similar to Claim 1, Claim 13 recites a cleaning solution "suitable for use in cleaning an epoxy-based resin from a surface." Therefore, Applicants submit that Claim 13 is also allowable over the *Doyel II* reference, for example, for reasons similar to those discussed above with regard to Claim 1. Applicants respectfully request that the rejection of Claim 13 be withdrawn.

Claim 25 recites:

A method of removing a furan-based resin coating from a surface comprising applying a cleaning solution comprising a pH-adjusting agent, a solvent, and water to a surface at least partially coated with a furan-based resin, wherein the solvent is selected from the group consisting of dipropylene glycol monomethyl ether, diethylene glycol monomethyl ether, and combinations thereof.

Applicants respectfully submit the *Doyel II* reference fails to teach, suggest, or disclose each of these elements as well. For example, *Doyel II* fails to teach, suggest, or disclose "applying a cleaning solution . . . to a surface at least partially coated with a furan-based resin." Instead, as discussed above with regard to the rejection of Claim 1, *Doyel II* discloses applying a cleaning solution to a surface at least partially coated with a "polymeric substance that is used in the manufacture of optical products that has a refractive index greater than 1.49." Col. 6, ll. 36-39. These include DEGBAC, acrylates, methacrylates, methyl methacrylates, polyesters, polystyrene, polycarbonate, phthalate, isocyanate, polyether, urethane, thio or sulfur containing polymers, and halo or chlorine and/or bromine containing polymers. Col. 6, ll. 39-53. *Doyel II* fails to teach, suggest, or disclose using the cleaning solution to remove a furan-based resin from a surface. For at least this reason, the rejection of Claim 25 is improper. Therefore, Applicants respectfully request that the rejection of Claim 25 be withdrawn.

Similar to Claim 25, Claim 33 recites a cleaning solution "suitable for use in cleaning a furan-based resin from a surface." Therefore, Applicants respectfully submit that Claim 33 is also patentable over the *Doyel II* reference, for example, for reasons similar to those discussed above with regard to Claim 25. Applicants respectfully request the full allowance of Claim 33.

Claims 2, 4, 5, 9, 12, 14, 16, 17, 21, 24, 26-29, 31, 32, 34-37, 39, and 40 depend from Claims 1, 13, 25, and 33. Therefore, Applicants respectfully submit that Claims 2, 4, 5, 9, 12, 14, 16, 17, 21, 24, 26-29, 31, 32, 34-37, 39, and 40 are allowable over the cited art, for example,

for reasons similar to those discussed above with regard to Claims 1, 13, 25, and 33. Applicants respectfully request the withdrawal of the rejection of Claims 2, 4, 5, 9, 12, 14, 16, 17, 21, 24, 26-29, 31, 32, 34-37, 39, and 40 and the full allowance of all pending claims.

B. Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, 24-29, 31-37, 39, and 40 are not Anticipated by *Kondoh*.

Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, 24-29, 31-37, 39, and 40 were also rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,954,891 issued to Kondoh ("*Kondoh*"). Applicants respectfully traverse these rejections for the reasons discussed below.

Applicants respectfully submit that each and every element of Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, 24-29, 31-37, 39, and 40 are not found within the *Kondoh* reference.

Claim 1 recites:

A method of removing an epoxy-based resin coating from a surface comprising applying a cleaning solution comprising a pH-adjusting agent, a solvent, and from about 35% to about 95% by volume water to a surface at least partially coated with an epoxy-based resin, wherein the solvent is selected from the group consisting of dipropylene glycol monomethyl ether, diethylene glycol monomethyl ether, and combinations thereof.

Applicants respectfully submit the *Kondoh* reference fails to teach, suggest, or disclose each of these elements. For example, *Kondoh* fails to teach, suggest, or disclose "applying a cleaning solution . . . to a surface at least partially coated with an epoxy-based resin." Instead, *Kondoh* discloses a "method for removing resinous stains . . . which are adhered to surfaces of hard materials and difficult to be removed." Col. 14, ll. 31-34. These include resins, such as plastic lens resins, adhesives, tackifiers, adhesives for temporary fixing, fixing agents, bonding agents, sealing agents, binders, paints, and protective films. Col. 14, ll. 34-67. However, *Kondoh* fails to teach, suggest, or disclose using the method for removing epoxy-based resins. In fact, *Kondoh* is entirely silent on the subject of epoxy-based resins. For at least this reason, the rejection of Claim 1 is improper. Therefore, Applicants respectfully request that the rejection of Claim 1 be withdrawn.

Similar to Claim 1, Claim 13 recites a cleaning solution "suitable for use in cleaning an epoxy-based resin from a surface." Therefore, Applicants submit that Claim 13 is also allowable

over the *Kondoh* reference, for example, for reasons similar to those discussed above with regard to Claim 1. Applicants respectfully request that the rejection of Claim 13 be withdrawn.

Claim 25 recites:

A method of removing a furan-based resin coating from a surface comprising applying a cleaning solution comprising a pH-adjusting agent, a solvent, and water to a surface at least partially coated with a furan-based resin, wherein the solvent is selected from the group consisting of dipropylene glycol monomethyl ether, diethylene glycol monomethyl ether, and combinations thereof.

Applicants respectfully submit the *Kondoh* reference fails to teach, suggest, or disclose each of these elements as well. For example, *Kondoh* fails to teach, suggest, or disclose “applying a cleaning solution . . . to a surface at least partially coated with a furan-based resin.” As discussed above with regard to the rejection of Claim 1, *Kondoh* discloses a “method for removing resinous stains . . . which are adhered to surfaces of hard materials and difficult to be removed.” Col. 14, ll. 31-34. These include resins, such as plastic lens resins, adhesives, tackifiers, adhesives for temporary fixing, fixing agents, bonding agents, sealing agents, binders, paints, and protective films. Col. 14, ll. 34-67. However, *Kondoh* fails to teach, suggest, or disclose using the method for removing furan-based resins. In fact, *Kondoh* is entirely silent on the subject of furan-based resins. For at least this reason, the rejection of Claim 25 is improper. Therefore, Applicants respectfully request that the rejection of Claim 25 be withdrawn.

Similar to Claim 25, Claim 33 recites a cleaning solution “suitable for use in cleaning a furan-based resin from a surface.” Therefore, Applicants respectfully submit that Claim 33 is also patentable over the *Kondoh* reference, for example, for reasons similar to those discussed above with regard to Claim 25. Applicants respectfully request the full allowance of Claim 33.

Claims 2, 4, 5, 9, 12, 14, 16, 17, 21, 24, 26-29, 31, 32, 34-37, 39, and 40 depend from Claims 1, 13, 25, and 33. Therefore, Applicants respectfully submit that Claims 2, 4, 5, 9, 12, 14, 16, 17, 21, 24, 26-29, 31, 32, 34-37, 39, and 40 are allowable over the cited art, for example, for reasons similar to those discussed above with regard to Claims 1, 13, 25, and 33. Applicants respectfully request the withdrawal of the rejection of Claims 2, 4, 5, 9, 12, 14, 16, 17, 21, 24, 26-29, 31, 32, 34-37, 39, and 40 and the full allowance of all pending claims.

C. Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, 24-29, 31-37, 39, and 40 are not Anticipated by *Cummings*.

Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, 24-29, 31-37, 39, and 40 were also rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,750,482 issued to Cummings ("*Cummings*"). Applicants respectfully traverse these rejections for the reasons discussed below.

Applicants respectfully submit that each and every element of Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, 24-29, 31-37, 39, and 40 are not found within the *Cummings* reference.

Claim 1 recites:

A method of removing an epoxy-based resin coating from a surface comprising applying a cleaning solution comprising a pH-adjusting agent, a solvent, and from about 35% to about 95% by volume water to a surface at least partially coated with an epoxy-based resin, wherein the solvent is selected from the group consisting of dipropylene glycol monomethyl ether, diethylene glycol monomethyl ether, and combinations thereof.

Applicants respectfully submit the *Cummings* reference fails to teach, suggest, or disclose each of these elements. For example, *Cummings* fails to teach, suggest, or disclose "applying a cleaning solution . . . to a surface at least partially coated with an epoxy-based resin." Instead, *Cummings* discloses a non-streaking glass cleaning composition for the removal of "soils and dirt from [a] glass surface . . . in a streakfree [sic] manner." Col. 1, ll. 19-21. *Cummings* fails to teach, suggest, or disclose removing epoxy-based resins from a surface. For at least this reason, the rejection of Claim 1 is improper. Therefore, Applicants respectfully request that the rejection of Claim 1 be withdrawn.

Similar to Claim 1, Claim 13 recites a cleaning solution "suitable for use in cleaning an epoxy-based resin from a surface." Therefore, Applicants submit that Claim 13 is also allowable over the *Cummings* reference, for example, for reasons similar to those discussed above with regard to Claim 1. Applicants respectfully request that the rejection of Claim 13 be withdrawn.

Claim 25 recites:

A method of removing a furan-based resin coating from a surface comprising applying a cleaning solution comprising a pH-adjusting agent, a solvent, and water to a surface at least partially coated with a furan-based resin, wherein the solvent is selected from the group consisting of dipropylene glycol monomethyl ether, diethylene glycol monomethyl ether, and combinations thereof.

Applicants respectfully submit the *Cummings* reference fails to teach, suggest, or disclose each of these elements as well. For example, *Cummings* fails to teach, suggest, or disclose “applying a cleaning solution . . . to a surface at least partially coated with a furan-based resin.” Instead, as discussed above with regard to the rejection of Claim 1, *Cummings* discloses a non-streaking glass cleaning composition for the removal of “soils and dirt from [a] glass surface . . . in a streakfree manner.” Col. 1, ll. 19-21. *Cummings* is entirely silent on removing furan-based resins from a surface. For at least this reason, the rejection of Claim 25 is improper. Therefore, Applicants respectfully request that the rejection of Claim 25 be withdrawn.

Similar to Claim 25, Claim 33 recites a cleaning solution “suitable for use in cleaning a furan-based resin from a surface.” Therefore, Applicants respectfully submit that Claim 33 is also patentable over the *Cummings* reference, for example, for reasons similar to those discussed above with regard to Claim 25. Applicants respectfully request the full allowance of Claim 33.

Claims 2, 4, 5, 9, 12, 14, 16, 17, 21, 24, 26-29, 31, 32, 34-37, 39, and 40 depend from Claims 1, 13, 25, and 33. Therefore, Applicants respectfully submit that Claims 2, 4, 5, 9, 12, 14, 16, 17, 21, 24, 26-29, 31, 32, 34-37, 39, and 40 are allowable over the cited art, for example, for reasons similar to those discussed above with regard to Claims 1, 13, 25, and 33. Applicants respectfully request the withdrawal of the rejection of Claims 2, 4, 5, 9, 12, 14, 16, 17, 21, 24, 26-29, 31, 32, 34-37, 39, and 40 and the full allowance of all pending claims.

D. Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, 24-29, 31-37, 39, and 40 are not Anticipated by *Dodge*.

Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, 24-29, 31-37, 39, and 40 were also rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,608,086 issued to Dodge (“*Dodge*”).

As an initial matter, Applicants respectfully point out that Applicants have already successfully overcome the *Dodge* reference, which was cited by the Examiner in the Office Action mailed July 1, 2005. Accordingly, these rejections are not only repetitive, but moot. Nonetheless, Applicants respectfully traverse these rejections for the reasons discussed below.

Applicants respectfully submit that each and every element of Claims 1, 2, 4, 5, 9, 12-14, 16, 17, 21, 24-29, 31-37, 39, and 40 are not found within the *Dodge* reference.

Claim 1 recites:

A method of removing an epoxy-based resin coating from a surface comprising applying a cleaning solution comprising a pH-adjusting agent, a solvent, and from about 35% to about 95% by volume water to a surface at least partially coated with an epoxy-based resin, wherein the solvent is selected from the group consisting of dipropylene glycol monomethyl ether, diethylene glycol monomethyl ether, and combinations thereof.

Applicants respectfully submit the *Dodge* reference fails to teach, suggest, or disclose each of these elements. For example, *Dodge* fails to teach, suggest, or disclose “a cleaning solution comprising . . . from about 35% to about 95% by volume water.” Instead, *Dodge* discloses a membrane remover/etchant solution having a total water level below 30% by weight. Col. 2, l. 68 - col. 3, l. 2. For at least this reason Claim 1 is allowable over the *Dodge* reference. Therefore, Applicants respectfully request that the rejection of Claim 1 be withdrawn.

Similar to Claim 1, Claim 13 also recites “[a] cleaning solution comprising . . . from about 35% to about 95% by volume water.” Therefore, Applicants submit that Claim 13 is also allowable over the *Dodge* reference, for example, for reasons similar to those discussed above with regard to Claim 1. Applicants respectfully request that the rejection of Claim 13 be withdrawn.

Claim 25 recites:

A method of removing a furan-based resin coating from a surface comprising applying a cleaning solution comprising a pH-adjusting agent, a solvent, and water to a surface at least partially coated with a furan-based resin, wherein the solvent is selected from the group consisting of dipropylene glycol monomethyl ether, diethylene glycol monomethyl ether, and combinations thereof.

Applicants respectfully submit the *Dodge* reference fails to teach, suggest, or disclose each of these elements as well. For example, *Dodge* fails to teach, suggest, or disclose “applying a cleaning solution . . . to a surface at least partially coated with a furan-based resin” (emphasis added). Instead, *Dodge* discloses using a membrane remover/etchant solution for use in removing curing membranes comprising chlorinated rubbers, oleo resins, acrylic resins or a combination of rubber and epoxy resin from concrete. Col. 1, ll. 35-42. *Dodge*, however, fails to teach, suggest, or disclose the use of its membrane remove/etchant solution to remove a furan-

based resin coating from a surface. Therefore, for at least this reason, Applicants submit that Claim 25 is patentable over the *Dodge* reference, and respectfully request the full allowance of Claim 25.

Similar to Claim 25, Claim 33 recites a cleaning solution “suitable for use in cleaning a furan-based resin from a surface.” Therefore, Applicants respectfully submit that Claim 33 is also patentable over the *Dodge* reference, for example, for reasons similar to those discussed above with regard to Claim 25. Applicants respectfully request the full allowance of Claim 33.

Claims 2, 4, 5, 9, 12, 14, 16, 17, 21, 24, 26-29, 31, 32, 34-37, 39, and 40 depend from Claims 1, 13, 25, and 33. Therefore, Applicants respectfully submit that Claims 2, 4, 5, 9, 12, 14, 16, 17, 21, 24, 26-29, 31, 32, 34-37, 39, and 40 are allowable over the cited art, for example, for reasons similar to those discussed above with regard to Claims 1, 13, 25, and 33. Applicants respectfully request the withdrawal of the rejection of Claims 2, 4, 5, 9, 12, 14, 16, 17, 21, 24, 26-29, 31, 32, 34-37, 39, and 40 and the full allowance of all pending claims.

V. No Waiver.

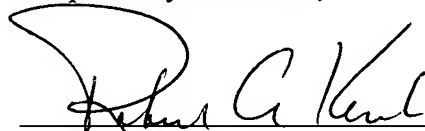
All of Applicants’ arguments are made without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the cited references. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in an Appeal, if appropriate. Moreover, Applicants’ silence in the face of any additional statements made by the Examiner should not be interpreted as acquiescence. Instead, Applicants believe the example distinctions discussed herein are sufficient to overcome the Examiner’s rejections.

SUMMARY

In light of the above remarks and amendments, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants believe no fee is due in association with the filing of this Amendment and Response. However, should the Commissioner deem that any fees are due, including any fees for extensions of time, Applicants respectfully request that the Commissioner accept this as a Petition Therefor, and direct that any additional fees also be charged to Deposit Account No. 08-0300.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert A. Kent", is written over a horizontal line.

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